

ESTTA Tracking number: **ESTTA5382**

Filing date: **02/05/2004**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92031118
Party	Plaintiff HARDCORE ENTERPRISES PTY. LTD.
Correspondence Address	JEFFREY L. VAN HOOSEAR KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET, FOURTEENTH FLOOR IRVINE, CA 92614
Submission	Motion for Sanctions
Filer's Name	Stacey R. Halpern
Filer's e-mail	efiling@kmob.com
Signature	/Stacey R. Halpern/
Date	02/05/2004
Attachments	Motion for Sanctions.pdf (13 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hardcore Enterprises Pty Ltd.,

Petitioner,

v.

RCN-Companhia de Importacao e Exportacao de
Texteis, Limitada,

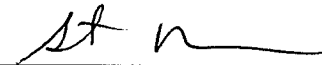
Respondent.

Cancellation No.: 92031118

I hereby certify that this correspondence and all marked
attachments are being electronically filed with the
Trademark Trial and Appeal Board through their web
site located at <http://estta.uspto.gov/> on:

February 5, 2004

(Date)



Stacey R. Halpern

PETITIONER'S MOTION FOR SANCTIONS

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

ATT: BOX TTAB NO FEE

Dear Sir:

Pursuant to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §527.01 and 37 C.F.R. §2.210(g), Petitioner, Hardcore Enterprises Pty Ltd., ("Petitioner") hereby RCN-Companhia de Importacao e Exportacao de Texteis, Limitada, ("Respondent"), in the form of an entry of judgment in favor of Petitioner in the above-identified cancellation action. This Motion is supported by the Memorandum of Points and Authorities set forth below and the attached Declaration of Stacey R. Halpern in Support of Petitioner's Motion for Sanctions (the "Halpern Declaration").

I. INTRODUCTION

As is discussed in detail below, Respondent has once again shown its unwillingness to comply with the TBMP, the Federal Rules of Civil Procedure (“FRCP”), and the Board’s December 29, 2003 Order (the “Board’s Order”), which directed Respondent to “fully respond without objection to petitioner’s first set of interrogatories and first set of requests for production of documents” by **January 29, 2004**, and which invited Petitioner to file a Motion for Sanctions if Respondent failed to comply with the Board’s Order.

Due to Respondent’s failure to comply with the Board’s Order, Petitioner respectfully requests that the Board enter judgment in favor of Petitioner and deem U.S. Trademark Registration No. 2,359,181 cancelled.

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT OF PETITIONER’S MOTION FOR SANCTIONS IN THE FORM OF A JUDGMENT IN PETITIONER’S FAVOR

A. Statement of Facts

On May 20, 2003, Petitioner timely served Petitioner’s First Set of Interrogatories (“Petitioner’s Interrogatories”), First Set of Requests for Production of Documents and Things (“Petitioner’s Document Requests”) and First Set of Requests for Admissions (“Petitioner’s Admission Requests”) (collectively “Petitioner’s Discovery Requests”). Accordingly, responses to Petitioner’s Discovery Requests were due June 24, 2003. In an effort to resolve this matter amicably, counsel for Petitioner sent several letters to counsel for Respondent. Halpern Declaration at ¶ 2. Counsel for Petitioner also telephoned Counsel for Respondent several times. Id.

As counsel for Respondent did not respond to any of counsel for Petitioner's communications, on August 20, 2003, Petitioner filed a Motion to Compel. Halpern Declaration at ¶ 3.

On December 29 2003, the Board issued the Board's Order, which indicated that "Respondent is allowed until 30 days from the date of this order to fully respond without objection to petitioner's first set of interrogatories and first set of requests for production of documents." In addition, the Board's Order indicated that "[i]n the event respondent fails to comply with this order, the Board may entertain a motion for discovery sanctions." Furthermore, the Board's Order deemed "petitioner's first set of requests for admission" as "admitted." Halpern Declaration at ¶ 4. Thus, the deadline for Respondent to provide responses to Petitioner's First Set of Discovery Requests and responsive documents was **January 29, 2004**. Id.

However, Respondent has simply ignored the Board's Order and failed to provide written responses to Petitioner's Interrogatories or Petitioner's Document Requests. Additionally, Respondent has failed to provide any responsive documents. Halpern Declaration at ¶ 5.

In fact, although Petitioner's counsel was not required to contact Respondent's counsel, subsequent to the issuance of the Board's Order, on January 21, 2004, Petitioner's counsel contacted Respondent's counsel in writing in an attempt to determine whether Petitioner intended to comply with the Board's Order. Halpern Declaration at ¶ 5. However, neither Petitioner nor Petitioner's counsel responded to this letter. Id.

In sum, Respondent has continuously ignored the TBMP, the Board's Order, and Petitioner's repeated attempts to resolve this matter without the Board's involvement. Instead, Respondent has missed numerous deadlines, including the Board's deadline. Such conduct has not only wasted Petitioner's time, money and efforts, but also wasted significant amounts of the

Board's time and efforts.

B. Per the Board's Order, the Board Should Sanction Respondent by Entering Judgment Against Respondent

Where, as here, a party fails to comply with an order of the Board relating to discovery, including an order compelling discovery responses, the Board may enter judgment against the disobedient party. Seligman & Latz, Inc. v. Merit Mercantile Corp., 222 U.S.P.Q. 341 (TTAB 1984). See also F.R.C.P. §37(b)(2)(C); 37 C.F.R. §2.120(g); and T.B.M.P. §527.01.

Specifically, despite the Board's Order compelling Respondent to provide responses (without objection) to Petitioner's Interrogatories and Petitioner's Documents Requests and all responsive documents, Respondent has failed to provide such responses or any responsive documents. As such, Respondent has failed to comply with the Board's Order.

Petitioner and the Board have granted Respondent more than enough time to respond to Petitioner's Discovery Requests. Nonetheless, Respondent continues to be unwilling to comply with the TBMP, the FRCP, the Board's Order, and even the numerous extensions provided by Petitioner. Moreover, as the Board's Order invited Petitioner to bring a motion for sanctions if Respondent failed to respond to the Board's Order, such sanctions are particularly appropriate in this matter.

CONCLUSION

None of the relevant circumstances are subject to dispute: (1) the Board's Order provided Respondent until January 29, 2003 to respond to Petitioner's Interrogatories and Petitioner's Document Requests without any objections and to provide responsive documents; (2)

Respondent has not provided responses or any responsive documents; (3) Respondent has failed to comply with the Board's Order; and (4) the Board's Order expressly stated that "[i]n the event respondent fails to comply with this order, the Board may entertain a motion for discovery sanctions." Accordingly, Respondent respectfully requests that judgment be granted in Petitioner's favor and that Registration No. 2,359,181 be cancelled. Furthermore, pursuant to TMBP §528.03, Respondent respectfully requests that the Board suspend proceedings in this opposition, including the commencement of Petitioner's Testimony Period, pending determination on this motion.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: February 5, 2004

By: 

Stacey R. Halpern
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
Attorneys for Petitioner,
Hardcore Enterprises Pty Ltd.

H:\DOCS\SRH\SRH-7170.DOC:sh
020504

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hardcore Enterprises Pty Ltd.,

Petitioner,

v.

RCN-Companhia de Importacao e Exportacao de
Texteis, Limitada,

Respondent.

Cancellation No.: 92031118

**DECLARATION OF STACEY R. HALPERN IN SUPPORT OF
PETITIONER'S MOTION FOR SANCTIONS**

1. I am a partner with Knobbe, Martens, Olson & Bear, LLP (the "Knobbe Firm"), intellectual property counsel for the Petitioner in the above-identified Cancellation proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. On May 20, 2003, Petitioner timely served Petitioner's Discovery Requests. Accordingly, responses to Petitioner's Discovery Requests were due June 24, 2003.

2. As is discussed in detail in the Declaration of Stacey R. Halpern in Support of Petitioner's Motion to Compel, in an effort to resolve this matter amicably, I sent several letters to counsel for Respondent. I also telephoned counsel for Respondent several times.

3. As counsel for Respondent did not respond to any of counsel for Petitioner's communications, on August 20, 2003, Petitioner filed a Motion to Compel.

4. On December 29, 2003 the Board issued the Board's Order, which directed

Respondent to “fully respond without object to petitioner’s first set of interrogatories and first set of requests for production of documents” by **January 29, 2004**, and which invited Petitioner to file a Motion for Sanctions if Respondent failed to comply with the Board’s Order.

5. On January 21, 2004, I sent Respondent’s counsel another letter, which attempted to determine whether Petitioner intended to comply with the Board’s Order. A copy of the January 21, 2004 letter is attached hereto as Exhibit 1. However, to date, neither Petitioner nor Petitioner’s counsel responded to this letter. Moreover, to date, Respondent has simply ignored the Board’s Order and failed to provide written responses to Petitioner’s First Sets of Interrogatories or Document Requests. Additionally, Respondent has failed to provide any responsive documents.

I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: February 5, 2004

By:



Stacey R. Halpern

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **PETITIONER'S MOTION FOR SANCTIONS and DECLARATION OF STACEY R. HALPERN IN SUPPORT OF PETITIONER'S MOTION FOR SANCTIONS** upon Respondent's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on February 5, 2004 addressed as follows:

Julie A. Greenberg
GIFFORD DRASS GROH SPRINKLE ANDERSON & CITKOWSKI PC
280 N. Old Woodward, Suite 400
Birmingham, MI 48009



Stacey R. Halpern

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street
Fourteenth Floor
Irvine, CA 92614
Tel 949-760-0404
Fax 949-760-9502
www.kmob.com

Stacey R. Halpern
949-721-6301
shalpern@kmob.com

January 21, 2004

VIA FACSIMILE

Julie A. Greenberg
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
280 N. Old Woodward, Suite 400
Birmingham, MI 48009

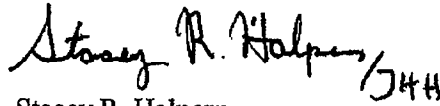
Re: U.S. Cancellation Proceeding
Our Client: Hardcore Enterprises Pty Ltd.
Your Client: RCN - Companhia de Importacao e Exportacao de Texteis, Limitada
Mark: GLOBELINE
Registration No.: 2,359,181
Class: 18
Cancellation No.: 31,118
Our Reference No: HRDCORE.025CN

Dear Julie

This letter is further to the Trademark Trial and Appeal Board's (the "Board") order of December 29, 2003 (the "Order"), a copy of which is enclosed for your reference. The Board's Order granted your client thirty (30) days in which to fully respond, without objection, to Hardcore Enterprises Pty Ltd.'s First Set of Interrogatories and First Set of Requests for Production of Documents. Accordingly, the deadline to provide us with your client's written responses and responsive documents is January 29, 2004.

We trust that your client will comply with the Board's Order. If you have any questions or need any additional information, please contact me.

Sincerely,


Stacey R. Halpern

Enclosure

cc: Shirley Del Rosario
Audrey Lee
Jonathan A. Hyman
L:\DOCS\JHHV\HH-6446.DOC
012104

Page 1 of 5

San Diego
619-235-8550

San Francisco
415-954-4114

Los Angeles
310-551-3450

Riverside
909-781-9231

San Luis Obispo
805-547-5580

HRDCORE.025CN

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: December 29, 2003

Cancellation No. 92031118

HARDCORE ENTERPRISES PTY. LTD.

v.

RCN - COMPANHIA DE IMPORTACAO
E EXPORTACAO DE TEXTAIS,
LIMITADA

Peter Cataldo, Interlocutory Attorney

On September 30, 2003, the Board suspended action in this proceeding pending the disposition of petitioner's motion to compel discovery responses (filed August 22, 2003).¹ In its motion to compel, petitioner seeks an order (1) compelling respondent to respond to its first set of interrogatories as well as its first set of requests for production of documents; (2) deeming admitted petitioner's first set of requests for admission²; (3) allowing petitioner "additional time to serve follow-up discovery";

¹ As such, petitioner's request that the Board suspend the commencement of its testimony period pending disposition of its motion to compel is moot.

² It is noted that petitioner, in its motion to compel, makes reference to Trademark Rule 2.120(h) with regard to its requests for admission. Accordingly, with regard to petitioner's admission requests, the Board construes petitioner's motion as one seeking to test the sufficiency of respondent's responses thereto.

and (4) sanctioning respondent in the event it fails to comply with a Board order to respond to petitioner's discovery requests.

Office records indicate no response thereto.

Motion to Compel

Accordingly, petitioner's motion to compel discovery responses is hereby granted as conceded to the extent indicated below. See Trademark Rules 2.120(e) and 2.127(a). Respondent is allowed until 30 days from the date of this order to fully respond without objection to petitioner's first set of interrogatories and first set of requests for production of documents.

Motion to Test Sufficiency of Responses to Admission Requests

In addition, petitioner's first set of requests for admission is deemed admitted. See Trademark Rules 2.120(h) and 2.127(a).

Request for Sanctions

In the event respondent fails to comply with this order, the Board may entertain a motion for discovery sanctions. Petitioner's request for discovery sanctions otherwise is premature and will be given no consideration. See Trademark Rule 2.120(g).

Request to Reopen Discovery

Petitioner's request to allow it additional time in which to propound follow-up discovery is, in essence, a

motion to reopen the discovery period, which closed in this proceeding on July 10, 2003. Petitioner's request is denied inasmuch as petitioner has failed to make a showing of excusable neglect sufficient to warrant a reopening of discovery. See *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership*, 507 U.S. 380 (1993); and *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

Dates Reset

Testimony periods are reset as indicated below. IN EACH INSTANCE, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party WITHIN THIRTY DAYS after completion of the taking of testimony. Trademark Rule 2.125.

DISCOVERY TO CLOSE:

CLOSED

Testimony period for party in
position of plaintiff to close March 30, 2004
(opening thirty days prior thereto)

Testimony period for party in
position of defendant to close May 29, 2004
(opening thirty days prior thereto)

Rebuttal testimony period to close July 13, 2004
(opening fifteen days prior thereto)

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * * * *

Don W. Martens*
James B. Bear
Darrell L. Olson*
William B. Bunker
William H. Nieman
Shur S. Rose
Jas F. Lesniak
Fred A. Israelson
Drew S. Hamilton
Jerry T. Sewell
John B. Sganga, Jr.
Edward A. Schlatter
Gerard von Hoffmann
Joseph R. Re
Catherine J. Holland
John M. Carson
Karen Vogel Well
Andrew H. Simpson
Jeffrey L. Van Hoosear
Daniel E. Altman
Stephen C. Jensen
Vito A. Canuso III
William H. Shreve
Lynda J. Zadra-Symast
Steven J. Nataupsky
Paul A. Stewart
Joseph F. Jennings
Craig S. Summers
AnneMarie Kaiser
Brenton R. Babcock
Thomas F. Smagal, Jr.
Michael H. Trenholm
Diane M. Reed
Ronald J. Schoenbaum
John R. King
Frederick S. Berretta
Nancy W. Vensko
John P. Glezentanner
Adeel S. Akhtar
Thomas R. Arno
David N. Weiss
Daniel Hart, Ph.D.
Douglas G. Muehlhauser
Lori Lee Yamato
Michael K. Friedland
Dale C. Hunt, Ph.D.
Richard E. Campbell
Paul D. Tripodi II
Judy R. Halpern
W. Henderson, Ph.D.
Mark M. Abumari
Jon W. Gurka

John W. Holcomb
Joseph M. Reisman, Ph.D.
Michael L. Fuller
Eric M. Nelson
Mark R. Benedict, Ph.D.
Paul N. Conover
Robert J. Roby
Sabine H. Lee
Karoline A. Delaney
Joseph S. Cianfrani
William R. Zimmerman
Paul C. Steinhart
Eric S. Furman, Ph.D.
Susan M. Natland
James W. Hill, M.D.
Deborah S. Shepherd
Glen L. Nuttall
Tirzah Abé Lowe
Sanjivpal S. Gill
Rose M. Thiessen, Ph.D.
Michael A. Gulliana
Mark J. Kertz
Rabinder N. Nerula
Bruce S. Itchkawitz, Ph.D.
Michael S. Okamoto
John M. Grover
Mallory K. De Merlier
Irfan A. Lateef
Amy C. Christensen
Sharon S. Ng
Mark J. Gallagher, Ph.D.
David G. Jankowski, Ph.D.
Brian C. Horne
Paysap J. LeMellieur
Sheila N. Swaroop
Ben A. Katzenellenbogen
Linda H. Liu
Andrew N. Merickel, Ph.D.
David L. Hauser
James F. Herkenhoff
Scott Loras Murray
Andrew M. Douglas
Marc T. Morley
Salma A. Morani, Ph.D.
Sam K. Tahmassebi, Ph.D.
Christy L. Green
Jonathan A. Hyman
Curtiss C. Dosier
Joseph J. Mallon, Ph.D.
Thomas P. Krzeminski
Sean M. Murray
Elenore Niu

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street
Fourteenth Floor
Irvine, CA 92614
Tel 949-760-0404
Fax 949-760-9502
knob.com

CONFIRMATION COPY WILL FOLLOW VIA:

- ☐ MAIL
- ☐ INTERNATIONAL AIRMAIL
- ☐ COURIER
- ☐ E-MAIL
- ☐ WILL NOT FOLLOW
- ☐ HAND DELIVERY
- ☐ WITH ENCLOSURES
- ☐ WITHOUT ENCLOSURES

Valerie L. Bracken
J. David Evered††
Jeremy P. Sanders
Perry D. Oldham
Jerry L. Hafner, Ph.D.
Russell M. Jelde
Abraham W. Chuang
Ryan N. Farr
Pui Tong Ho, Ph.D.
Erik T. Anderson
John L. Paik
Eric K. Morton
Jesse A. Rothwell
Marc C. Baumgartner
Ray B. Hom
Danielle Klausner
Kyle F. Schlueter
Raphael A. Gutierrez
Dimitri K. Jackson
Nathan A. Engels
Gregory A. Hermanson
Zi Y. Wong
John N. Kandara
Matthew S. Bellinger
David K. Wiggins
Darryl H. Steensma, Ph.D.
Lauren Keller
Ted M. Cannon
Carol M. Pitzel
Josue A. Villalva
Sheila R. Gibson
Andrew I. Kimmel
Mika Fukawa
Curtis R. Huffmire
Tina Chen
Brendon Gingrich, Ph.D.
Arman H. Nadershahi
Christopher L. Ross
Don W. Anthony, Ph.D.
John G. Rickensbrode
Aaron D. Barker
Christian A. Fox
M. Todd Hales
Ell A. Looze, Ph.D.
Jennifer L. Enmon, Ph.D.
Shuaib A. Altque
Ryan E. Melnick, Ph.D.
Brian C. Leubitz
Yanna S. Bouris
Phillip M. Nelson

Of Counsel
Louis J. Knobbe*
Jerry R. Sellar

Japanese Patent Atty
Katsuhiko Arai
Tomohisa Sugiyama

Korean Patent Atty
Mincheol Kim
Heungsoo Choi

Scientists & Engineers (Non-Lawyers)

Reimond J. Saleniks**
Khurram Rahman, Ph.D.
Jennifer Haynes, Ph.D.**
Tommy Y. Nagata
Che S. Cherskin, Ph.D.**
James W. Austley**
Jennifer Hayes**
Kirk E. Pastorian, Ph.D.**
Connie C. Tong, Ph.D.**
Suzanne Jepson, Ph.D.**
Nira M. Brand**
Jeffrey A. Hopkins**
Tiffany C. Miller**
James W. Cheng, Ph.D.**
Marina L. Gordey, Ph.D.**
W. Frank Dauerer
Lang J. McHardy**
Karen J. Lenker
Chris Westberg, Ph.D.
Eric B. Ivas, Ph.D.**
Raymond D. Smith, Ph.D.

* A Professional Corporation
† Also Barrister At Law (Eng. & Wales)
** U.S. Patent Agent
†† Also Solicitor (Eng. & Wales)

Facsimile Transmittal Sheet

Confidentiality Notice:

The documents accompanying this facsimile transmission contain confidential information which may be legally privileged. The information is intended only for the use of the recipient named below. If you have received this facsimile in error, please immediately notify us by telephone to arrange for return of the original documents to us; and any disclosure, copying, distribution or the taking of any action in reliance on the contents of this faxed information is strictly prohibited.

To: Julie A. Greenberg
FIRM: GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
FACSIMILE NO.: (248) 647-5210
FROM: Jonathan A. Hyman
DATE: January 21, 2004

OUR REF.: HRDCORE.025CN
YOUR REF.:
OPERATOR: aa
NO. OF PAGES: 5 (incl. cover sheet)
TIME:

IF YOU DID NOT RECEIVE ALL OF THE PAGES PLEASE CALL BACK IMMEDIATELY

OPERATOR PHONE NO.: (310) 551-3450

FACSIMILE NO.: (310) 551-3458

MESSAGE: _

550 West C Street
Suite 1200
San Diego CA 92101
Tel 619-235-8550
Fax 619-235-0176

201 California Street
Suite 1150
San Francisco CA 94111
Tel 415-954-4114
Fax 415-954-4111

1900 Avenue of the Stars
Suite 1425
Los Angeles CA 90067
Tel 310-551-3450
Fax 310-551-3458

3403 Tenth Street
Suite 700
Riverside CA 92501
Tel 909-781-9231
Fax 909-781-4507

1114 Marsh Street
San Luis Obispo CA 93401
Tel 805-547-5580
Fax 805-547-5590

Page 5 of 5